REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above.

Previous claims 12-23 have been canceled without prejudice to the filing of a divisional application later on.

The sole issue is thus the rejection of claims 24-35 under 35 USC § 103(a) as being obvious over Bries et al. ("Bries"), WO 95/06691. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

The "whereby" clause of main claim 24 reads as follows:

> "whereby the backing is selected such that the backing would tear if pulled ***by itself*** with the same force necessary to remove said adhesive tape from said substrate, but the backing does not tear when said adhesive tape is removed from said substrate."

This "whereby" clause embodies two tests that must be satisfied in order to read on the claims:

(1) the backing ***would tear*** if pulled by itself (backing alone) with the same force

necessary to remove the adhesive tape from the substrate; ***and***

(2) the backing ***does not tear*** when the adhesive tape (backing + adhesive) is removed from the substrate.

At the bottom of page 3 of the final rejection, the Examiner states his position as follows:

> "Turning to independent claim 24 it is noted that the claim is substantially identical to independent claim 12 except for the presence of a whereby clause in which applicants make the selection that the backing must be selected such that it will tear if pulled by itself with the same force necessary to remove the adhesive tape from the substrate, but the backing will not tear when the adhesive tape is removed from the substrate. However, ***since the adhesive tapes of the reference either expressly or inherently meet this parameter,*** and would be subject to the minor obvious change in their adhesive strength as noted above to so assist their removability properties, the examiner remains firmly convinced that they are not believed to have ***rebutted*** the *prima facie* case of record."

[Emphasis added.]

In response, Applicants point out that these arguments have not been made in an attempt to rebut any *prima facie* case of anticipation and/or obviousness established. Rather, Applicants content that Bries does not make out a *prima facie* case of either anticipation or obviousness,

and, thus, no rebuttal is necessary.

As the proponent of this rejection, the burden was on the Examiner in the first instance to make out a prima facie case of either anticipation and/or obviousness. The Examiner says that Bries either expressly or inherently teaches what is required by the whereby clause of claim 24. Applicants respectfully request that the Examiner make a decision on this point.

If Bries expressly teaches what is required by the whereby clause of claim 24, then Applicants respectfully request that the Examiner point to the pertinent portion of Bries where such express teaching can be found by page and line numbers. Applicants have carefully studied Bries and can find no express teaching of the whereby clause of claim 24.

If Bries inherently teaches what is required by the whereby clause of claim 24, then Applicants respectfully request that the Examiner point to the pertinent portions of Bries that support this theory, and also explain why inherency necessarily flows from such pertinent portions of Bries. In this regard, Applicants remind the Examiner that if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson,* 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.*

Applicants submit that a case of inherency as to the whereby clause of claim 24 cannot possibly be made out. It is certainly not necessarily the case that a backing selected from among Bries' teachings must meet the two-prong test required by the whereby clause of claim 24, which, again, requires that:

(1) the backing ***would tear*** if pulled by itself (backing alone) with the same force necessary to remove the adhesive tape from the substrate; ***and***

(2) the backing ***does not tear*** when the adhesive tape (backing + adhesive) is removed from the substrate.

Certainly, a backing can be selected from within Bries' disclosure that would not tear if pulled by itself with the same force necessary to remove the adhesive tape from the substrate, and, therefore, also would not tear when the adhesive tape is removed from the substrate. Indeed, the tenor of Bries' entire disclosure is directed towards thick backings, which, thus, might not be expected to tear if subjected to the force required to remove the adhesive tape. Consequently, by no stretch of the imagination can the whereby clause of claim 24 be inherent in Bries. It simply is not necessarily the case that Bries' backings meet the test of the whereby clause of claim 24, and, thus, there is no inherency.

Since Bries' neither expressly nor inherently meets the terms of the whereby clause of claim 24, none of the instant claims can be either anticipated by or obvious in view of Bries. In short, Applicants believe the Examiner would be fully justified to reconsider and withdraw this

rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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By _____

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